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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,095	08/22/2003	Doron Friedman	F0011/7005	8394

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EXAMINER	
JEAN, FRANTZ B	

ART UNIT	PAPER NUMBER
2154	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/646,095	FRIEDMAN ET AL.	
	Examiner	Art Unit	
	Frantz B. Jean	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-17 and 19-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-17 and 19-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/07 has been entered.

Claims 1, 3, 5-17 and 19-22 are still pending in this application.

In regard to the 101's rejection of claims 3-5, the specification defines the medium to be a carrier wave, which is not tangible. Therefore, it is concluded that claims 3-5 are non-statutory. The medium must be stored. The word tangible is no longer accepted to correct the claim deficiency regarding 101's matter. Correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 5-17 and 19-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,965,912. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the claims of patent number "912, which encompass the same metes and bounds. It has been held that omission of an element and its function and a combination where the remaining elements perform the same function as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

Claims 1, 3, 5-17 and 19-22 of the instant application are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of copending patent application publication number 2004/0205138A1 and claims 1-24 of copending patent Application Publication No.2006/0036681A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the claims of copending patent application publication number "138" and copending patent application publication number "681", which encompass the same metes and bounds. It has been held that omission of an element and its function and a combination where the remaining elements perform the same function as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 3-5 are directed to a computer program product comprising computer usable medium having program code embodied thereon. However, the specification defines the medium to be a carrier wave, which is not tangible. Therefore, it is concluded that claims 3-5 are non-statutory. Correction is required.

During patent examination, the pending claims have been "given* their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-17 and 19-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Small US patent number 5,513117.

As per claim 1, Small teaches In a computer system connectable to a computer network, a method comprising: (a) maintaining in a memory data defining a greeting card and any modifications thereto; (b) printing the greeting card in conjunction with any modifications thereto; (c) printing readable data on the greeting card; and (d) generating from the readable data printed on the greeting card any of a shipping label identifying at least one item to be shipped in conjunction with the printed greeting card (see fig 1-4 and 7-9;abstract; col. 2 line 30 to col. 3 line 59).

As per claim 3, Small teaches a computer program product for use with a computer system operatively coupled to a computer network comprises a computer usable medium having program code embodied thereon, the program code comprising: (a) program code for maintaining in a memory data defining a greeting card and any modifications thereto; (b) program code for printing the greeting card in conjunction with any modifications thereto; (c) program code for printing readable data on the greeting card; and (d) program code for generating from the readable data printed on the greeting card a document comprising a packing list identifying at least one item to be shipped in conjunction with the printed greeting card (see fig 1-4 and 7-9;abstract; col. 2 line 30 to col. 3 line 59).

As per claim 5, Small teaches a computer program product of claim 3 wherein the document further comprises a shipping label identifying a destination of the printed greeting card (fig 6-7 and 9).

As per claim 6, Small teaches in a computer system connectable to a computer network, a method comprising: (a) providing a printed personalized greeting card having readable data printed thereon; (b) reading the reference data from the greeting card; (c) using the read data to access in memory data defining any of a greeting card destination address, SKU, and lot number identifying a gift with which the personalized greeting card will be shipped; (d) generating a label from the accessed data in memory (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 7, Small teaches a method of claim 6 wherein the label comprises a packing list identifying at least one item to be shipped in conjunction with the printed greeting card (fig 6-7 and 9; col. 7 lines 14 et seq).

As per claim 8, Small teaches a method of claim 6 wherein the label comprises a shipping label identifying a destination of the printed greeting card (fig 6-7 and 9).

As per claim 9, Small teaches a computer system of claim 6 wherein the reference data comprises a bar code identifying any of a destination address, SKU and lot number of a gift to be shipped with the greeting card (see fig 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 10, Small teaches a method of claim 6 further comprising: (e) maintaining

in memory data representing any of a lot number identifying a gift with which the personalized greeting card will be matched, and a destination shipping address (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 11, Small teaches a computer system connectable to a computer network comprising: (a) a processor; (b) a memory coupled to the processor for storing data defining a card and any modifications thereto; (c) a printer coupled to the processor and memory for printing the card in conjunction with any modifications, and readable reference data thereon; and (d) program logic configured to read the reference data from the card and generate a label therefrom (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 12, Small teaches a computer system of claim 11 wherein the reference data is direct source of information for generating a shipping label containing at least a destination address to which the card will be sent (see fig 7, 9, 10-11 and 13).

As per claim 13, Small teaches a computer system of claim 11 wherein the reference data is usable to access a file containing the information for generating a shipping label containing at least a destination address to which the card will be sent (see fig 7, 9, 10-11 and 13).

As per claim 14, Small teaches a computer system of claim 11 wherein the reference

data is a source of information for generating an intermediate label used for matching at least one item to be shipped with the card (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 15, Small teaches a computer system of claim 11 wherein the reference data is a source of information for generating any of a gift card, envelop and gift certificate to be shipped with the card (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 16, Small teaches In a computer system connectable to a computer network, a method comprising: (a) maintaining in a memory data defining a greeting card and any modifications thereto; (b) printing the data defining a greeting card and any modifications on paper stock to make an n panel greeting card, where n is greater than two; (c) printing readable data on one of the n panels of the greeting card, the readable data comprising data identifying a product with which the greeting card will be matched, and a destination shipping address (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 17, Small teaches In a computer system connectable to a computer network, a method comprising: (a) maintaining in a memory data identifying one of a plurality of document templates and any personalization modifications thereto; (b) printing a personalized document comprising the document template in conjunction with

any personalization modifications thereto; (c) printing a data reference on the personalized document; and d) maintaining, in a memory, reference data representing one of data identifying a product with which the personalized document will be matched, and a destination shipping address (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 19, Small teaches a method of claim 17 wherein the reference data comprises a bar code (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 20, Small teaches a method of claim 17 further comprising: (e) generating from the reference data printed on the document one of a destination shipping label, envelop (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 21, Small teaches a method of claim 17 wherein the reference data comprises a packing list of at least one product to be shipped with the document (see fig 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 22, Small teaches a method of claim 17 wherein the plurality of document templates comprise any of greeting cards, promotional advertisements, and catalogs (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

Response to Arguments

Applicant's arguments filed on 10/29/07 have been fully considered but they are not persuasive.

Contrarily to applicants' assertion that Small does not teach certain features of the invention, Examiner submits that Small teaches all the concepts and aspects of the invention as claimed (see detailed rejection above). Examiner believes the claims are still broadly written; therefore, they are not defined over the prior art of record to Small. Accordingly, the rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frantz Jean

FRANTZ B. JEAN
PRIMARY EXAMINER